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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,348	12/08/2000	Eric Schneider		2277

24226 7590 04/03/2006

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EXAMINER

PWU, JEFFREY C

ART UNIT PAPER NUMBER

2143

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,348

Applicant(s)

SCHNEIDER, ERIC

Examiner

Jeffrey C. Pwu

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2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112^{1st}

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure lacks clear written description in a description of a third marking including access information for accessing a locator service via a communication network to assist the sender in locating current contact information for the recipient. It is unclear how to facilitate this step using applicant's disclosure.

3. Claims 42 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure lacks clear written description in a description on access information is selected from the group of telephone number, postal address, e-mail address, domain name, Uniform Resource Identifier and locator service identifier. It is unclear what is the relationship

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between access information and telephone number or postal address or e-mail address or domain name or Uniform Resource Identifier and/or locator service identifier.

Claims 43-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure lacks clear written description in a description on a third marking being marked upon the mail piece at any time after said second marking is marked and before said mail carrier returns the mail piece to said sender address. Nowhere in the specification discloses or describes this feature. It is unclear of who or how or when to place a third marking.

Claim Rejections - 35 USC § 112^{2nd}

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 42 and 49 recite the limitation "the group of" in claim 41. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 41-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Sansone (U.S. 6,549,892).

Sansone teaches claims

Claim 41. A mail piece including a plurality of markings for delivery to a recipient from a sender, comprising:

a first marking including a sender address and a recipient address; (39)

a second marking indicating that the mail piece is undeliverable to the recipient; (“a mail piece may be marked "Undeliverable as Addressed" when in fact the address is correct. Sometimes this happens because of a mistake on the part of a Postal Service employee. Other times, the addressee may have provided a change of address shortly after having moved, almost ninety days earlier, and then a mailing company, without pre-screening its mailing addresses before addressing its mail, uses an address for which the forwarding instructions expire before the mail can be delivered. In that case, the Postal Service will mark the mail, correctly, as "Undeliverable as Addressed," and then the company's internal address database should be updated with current address information from, for example, the U.S. Postal Service National Change of Address (NCOA) database.” At col.1, line 57) and,

a third marking including access information for accessing a locator service via a communication network to assist the sender in locating current contact information for the recipient. (“col.3, line

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54 - Database 68 uses a unique code number to determine the actual destination that the recipient wants the mail deliver to.”)

Claim 42. A mail piece, as set forth in claim 41, wherein said access information is selected from the group of telephone number, postal address, e-mail address, domain name, Uniform Resource Identifier and locator service identifier, the mail piece includes an envelope, and said selected access information is marked upon said envelope. (the access information is selected from postal address and locator service identifier)

Claim 43. A mail piece, as set forth in claim 41, wherein said second marking instructs a mail carrier to return the mail piece to said sender address. (“Letters or packages addressed to a correct recipient postal address are sometimes not delivered because the recipient may have moved and not yet completed a change-of-address form with the United States Postal Service (USPS). In that case, what likely would have happened is that the new resident of the address would have marked the mail "Not at this Address" and put it back in a mail box. However, since the Postal Service would have no better address, it would have marked the mail piece "Undeliverable as Addressed," endorsed the piece with "No Forwarding Address," and returned the mail piece to the sender. In this scenario, the piece of mail returned to the sender is marked "Undeliverable as Addressed," and is, in fact, undeliverable as addressed.”)

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Claim 45. A mail piece, as set forth in claim 41, wherein said sender address is a sender postal address and said recipient address is a recipient postal address. (see fig.3B)

Claim 46. A method for returning to a sender mail for a recipient, comprising the steps of: receiving mail including a sender address and a recipient address; determining that the mail is undeliverable to the recipient; adding to the mail access information for accessing a locator service via a communication network to assist the sender in locating current contact information for the recipient; and, delivering the mail to said sender address. (claim 46 is similarly rejected as in claims 41-43)

Claim 47. A method for returning to a sender mail for a recipient, as set forth in claim 46, wherein said sender address is a sender postal address and said recipient address is a recipient postal address. (claim 47 is similarly rejected as in claims 41-43)

Claim 48. A method for returning to a sender mail for a recipient, as set forth in claim 46, further including instructing a mail carrier to return the mail to said sender address. (claim 48 is similarly rejected as in claims 41-43)

Claim 49. A method for returning to a sender mail for a recipient, as set forth in claim 46, wherein said step of adding to said mail access information includes the step of selecting access information from the group of telephone number, postal address, e-mail address, domain name, Uniform Resource Identifier and locator service identifier.

Claim 50. A method for returning to a sender mail for a recipient, as set forth in claim 49, wherein said step of adding to said mail access information further includes the step of marking said access information upon said mail. (claim 50 is similarly rejected as in claims 41-45)

Claim 51. A method for returning to a sender mail for a recipient, as set forth in claim 49, wherein said step of adding to said mail access information further includes the step of stamping said access information upon said mail. (claim 51 is similarly rejected as in claims 41-43)

Claim 52. A method for returning to a sender mail for a recipient, as set forth in claim 49, wherein said step of adding to said mail access information further includes the step of inking said access information upon said mail. (claim 52 is similarly rejected as in claims 41-43)

Claim 53. A method for returning to a sender mail for a recipient, as set forth in claim 50, wherein the mail includes an envelope and said step of marking said access information upon said mail includes the step of marking said access information upon said envelope. (claim 53 is similarly rejected as in claims 41-43)

Claim 54. A method for returning to a sender mail for a recipient, as set forth in claim 51, wherein the mail includes an envelope and said step of stamping said access information upon said mail includes the step of stamping said access information upon said envelope.

Claim 55. A method for returning to a sender mail for a recipient, asset forth in claim 52, wherein the mail includes an envelope and said step of inking said access information upon said mail includes the step of inking said access information upon said envelope. (claim 55 is similarly rejected as in claims 41-43)

Claim 56. A method for returning to a sender mail for a recipient, as set forth in claim 46, wherein the mail includes an envelope and said step of adding to said mail access information includes the step of placing an advertisement for a locator service upon said envelope. (claim 56 is similarly rejected as in claims 41-43)

Response to Arguments

8. Applicant's arguments with respect to claims 41-56 have been considered but are moot in view of the new ground(s) of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey C. Pwu whose telephone number is 571-272-6798. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



3/25/06
JEFFREY PWU
PRIMARY EXAMINER